

S/N 10/038,766
Our Ref. No. 659-919
Client Ref. No. 16936

REMARKS

In the Office Action mailed November 22, 2005, the Examiner rejected claim 21 as being anticipated by U.S. Patent No. 5,291,692 to Takahashi et al. and U.S. Patent No. 4,578,133 to Oshefsky. The Examiner also rejected claims 2, 3 and 6-8 as being obvious¹ over Oshefsky in view of U.S. Patent No. 4,578,133 to McCabe and U.S. Patent No. 5,853,530 to Allen.² The Examiner has further rejected claims 7 and 8 under 35 U.S.C. 103 as being obvious over Oshefsky in view of McCabe, Allen and U.S. Patent No. 5,716,478 to Boothe. Finally, the Examiner has rejected claims 17-20 under 35 U.S.C. 103 as being obvious over Boothe in view of one or more of U.S. Patent No. 4,608,115 to Schroth, Allen and McCabe. Applicants respectfully submit that all of the claims are allowable for the reasons set forth below.

Claim 21:

Claim 21 now recites that a "*bottom surface* of said recessed portion [has] a *first predetermined shape* relative to said top portion and *said top portion* [has] a *second predetermined shape* relative to said recessed portion when said bottom surface of said recessed portion and said top portion are viewed along an axis substantially normal to said bottom surface of said recessed portion," and that the "*first predetermined shape* of said bottom surface of said recessed portion and said

¹ Although the Examiner has stated that claims 2, 3 and 6-8 are "rejected under 35 U.S.C. 102(b)," Applicants assume she meant that they are rejected under 35 U.S.C. 103, since the references are being applied in combination. If Applicants have misunderstood this rejection, they respectfully request clarification on the next Office Action.

² It does not appear that U.S. Patent No. 5,853,530 to Allen has been listed on a Form PTO-1449 or Form PTO-892 of record in this application. Accordingly, Applicants have submitted herewith a Form PTO-1449 and ask that the Examiner initial the form to indicate her consideration of Allen.

S/N 10/038,766
Our Ref. No. 659-919
Client Ref. No. 16936

second predetermined shape of said top portion *remain fixed* as carrier body is rotated about said axis [substantially normal to said bottom surface of said recessed portion].” In this way, the carrier body is “dimensioned and configured to accommodate the portion 38 (FIG. 3) of the discrete part 26 that is thicker relative to other portions 40 of the discrete parts” (Specification at 9, lines 15-17). Both the shape of the recessed portion and the shape of the top portion remain fixed during the operation and rotation of the carrier body.

In contrast, the entire premise of Oshefsky is to provide a transfer member having support strips 32, 272, 274 “whose configuration, and that of the discrete strips adhered thereto, is then changed to a desired curvilinear configuration” as the transfer member 260 is rotated (Oshefsky at Abstract, at Col. 2, lines 30-45; at Col. 14, lines 42-65; at Col. 15, lines 29-57). Accordingly, both the portion between strips 272, 274 (applied by the Examiner as the recessed portion – Office Action at 4), and the strips themselves (applied as the top portion - Office Action at 4), change their shape as the transfer member is rotated. Accordingly, claim 21 is patentable over Oshefsky.³

Claim 21 also recites “at least one aperture in said *top portion* of said outer surface and extending through said carrier body for communication with a vacuum source.” In contrast, Takahashi teaches that the communicating holes 18 are in the surface between the step portions 27, applied by the Examiner as the top portion. Nowhere does Takahashi disclose or suggest that holes 18 extend through the step portions 27. Accordingly, Takahashi fails to disclose or suggest all of the limitations of claim 21 and it should be passed to allowance on the next Office Action.

³ Applicants have also added new claim 28, which recites that “said top portion and said recessed portions are integrally formed as a single unitary component.” Accordingly, claim 28 further distinguishes over Oshefsky for this additional reason.

S/N 10/038,766
Our Ref. No. 659-919
Client Ref. No. 16936

Claims 2, 3 and 6-8:

Claims 3 recites that the “recessed portion has a *fixed, non-changeable* generally hour-glass shape.” As explained above, Oshefsky teaches that the shape of the support strips, and the space defined therebetween, is necessarily changeable for the operation of the invention. Indeed, if the shape of the support strips were “fixed,” the apparatus of Oshefsky would be rendered inoperative. Accordingly, there is no suggestion to substitute a carrier body having a recess with a fixed shape, as taught by any other reference, for the transfer member 260 as taught by Oshefsky.

Claims 17-20:

Claim 17 recites that the “outer surface [includes] at least one generally *convex* recessed portion having a generally *convex* bottom surface.” In contrast, none of Boothe, Schroth, Allen or McCabe disclose or suggest a “convex” recessed portion. Indeed, the Examiner repeatedly acknowledges that Boothe does not even disclose that “the transfer segment 40 has a recessed portion having a bottom surface” (Office Action at 9, 11 and 13). McCabe has a similar deficiency.

Moreover, as explained in Applicants’ prior Amendment and Reply to October 6, 2003 Office Action filed January 8, 2004, Schroth also fails to disclose or suggest a convex recessed portion. Rather, the surface 119 of Schroth is substantially planar, not curved, and either the grooves 116 and 118 are planar or concave in shape, not convex as set forth in claim 17. Applicants note that the Examiner previously found this argument persuasive and withdrew her rejection of claim 1, presumably on that basis (see Office Action Mailed April 8, 2004 at 6, para. 9, “Applicants arguments with respect to claims 1-4, 609, and 11-21 have been considered but are moot in view of the new grounds of rejection.”). Finally, as with Schroth, Allen also teaches a flat

S/N 10/038,766
Our Ref. No. 659-919
Client Ref. No. 16936

or “planar” surface 62 on the recessed portion (Col. 8, lines 65-66). Accordingly, all of the references, even if properly combined, which Applicants dispute, do not disclose all of the limitations of claim 17 and the Examiner’s rejection must therefore be withdrawn (MPEP 2142, 2143, 2143.03).

Conclusion:

For all of the reasons set forth above, all of the claims are in condition for allowance and notice to that effect is earnestly solicited. No fees are believed to be due in connection with this amendment. If for any reason this application is not considered to be in condition for allowance and an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to call the undersigned attorney at (312) 321-4713.

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By:

Respectfully Submitted,


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